

DOCKET NO.: 286785US8PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
Koujirou TANAKA

SERIAL NO: 10/572,580

GROUP: 2484

EXAMINER: SHIBRU, H.

FILED: March 20, 2006

FOR: CONTENT PROCESSING DEVICE, CONTENT PROCESSING METHOD,
AND COMPUTER PROGRAM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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Koujirou TANAKA : EXAMINER: SHIBRU, H.

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REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant requests a Pre-Appeal Brief Conference be initiated in accordance with the Pilot Program outlined in the Official Gazette Notice of July 12, 2005, and extended in the Official Gazette Notice of February 7, 2006.

GROUNDS FOR REVIEW

The Office Action issued January 24, 2011, (hereinafter "Office Action") rejected independent Claims 1 and 10-11 under 35 U.S.C. § 103(a) as obvious over U.S. Patent App. Publ'n No. 2004/0261093 to Rebaud et al. (hereinafter "Rebaud") in view of U.S. Patent App. Publ'n No. 2005/0203853 to Yamamoto et al. (hereinafter "Yamamoto") and rejected dependent Claim 3 under 35 U.S.C. § 103(a) as obvious over Rebaud in view of Yamamoto and Official Notice.

Those rejections are erroneous for committing at least the following four clear errors:

- 1) Rebaud and Yamamoto do not establish a *prima facie* case of obviousness.
- 2) The Office Action selected a species absent consideration as to the obviousness thereof.
- 3) The Office Action procedurally erred by prematurely shifting the evidentiary burden to Applicant.
- 4) The Office improperly maintained its taking of Official Notice.

REBAUD AND YAMAMOTO DO NOT ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS.

Rebaud concerns a system that “disallows delivery of . . . media items to client devices that are capable of copying the media . . .”¹ According to Rebaud, “To prevent devices that can copy digital media from having access . . ., [a] media service provider reviews various media rendering devices and determines whether the device should be approved.”² Thus, in Rebaud, “a stereo receiver that outputs analog signals for a speaker system might be approved, whereas a stereo receiver that also has a digital output may not be.”³ Rebaud describes another embodiment in which the system is “configured to deliver media content . . . conditionally based on the ratings associated with the media content.”⁴

That is, Rebaud merely describes disallowing delivery based on capabilities of a client device and ratings associated with media content. Rebaud is silent as to disallowing delivery relative to a providing source of the media content.

¹ Rebaud, para. [0018].

² Id., para. [0038].

³ Id.

⁴ Id., para. [0048].

The Amendment filed March 1, 2011, provided arguments how Rebaud fails to disclose aspects of the display of title information recited in Claim 1.⁵ Further, the Office Action acknowledged Rebaud does not even broadly disclose details of the display of title information recited in Claim 1.⁶

Meanwhile, Yamamoto concerns a display unit that displays grayed out buttons for content that is not playable.⁷ In a Yamamoto content playability judgment processing, if key generation information of a playback content indicates “medium key,” a key control unit judges whether the specified content is playable based on playability information of the content.⁸ According to Yamamoto, if the key generation information does not indicate “medium key,” whether the specified content is playable is judged based on the playability information,⁹ based on whether a rights key exists,¹⁰ and based on a playback count and playback expiration.¹¹

Yamamoto does not disclose or suggest judging whether the content is playable relative to a providing source of the content. Similar arguments were set forth in the Amendment filed November 9, 2010.¹²

Thus, Rebaud and Yamamoto, taken alone or in combination, fail to disclose the display of title information recited in independent Claims 1 and 10-11. Those references therefore fail to establish a *prima facie* case of obviousness as to the features of the independent claims.

⁵ Amendment filed March 1, 2011, at 7.

⁶ Office Action at 8 (acknowledging Claim 1 does not require the recited non-reproducibility decision basis to differ from Rebaud).

⁷ Yamamoto, para. [0112].

⁸ Id., para. [0145].

⁹ Id., para. [0146].

¹⁰ Id.

¹¹ Id., para. [0153].

¹² Amendment filed November 9, 2010, at 9.

**THE OFFICE ACTION SELECTED A SPECIES ABSENT CONSIDERATION AS TO
THE OBVIOUSNESS THEREOF.**

The Office Action generalized Yamamoto as teaching a display “such that the user can identify the programs that the user has the right to view.”¹³ Even assuming Yamamoto discloses a genus of displaying title information, the Office Action omitted consideration of whether it would have been obvious to select from within that genus a display of title information *as claimed*. Such an omission clearly contravenes established Office policy and substantive law.¹⁴

**THE OFFICE ACTION ERRED PROCEDURALLY BY PREMATURELY SHIFTING
THE EVIDENTIARY BURDEN TO APPLICANT.**

Thus, the Office Action failed to establish a *prima facie* case of obviousness as to the features of the independent claims. In reply, the Advisory Action issued March 28, 2011, relied on In re Keller, 208 USPQ 871 (CCPA 1981), for the proposition that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.¹⁵

The Advisory Action mischaracterizes In re Keller. Keller made clear that, “*Once a prima facie case of obviousness was established . . . , the burden shifted to appellant to rebut it . . . with objective evidence of non-obviousness.*”¹⁶ Here, the Office has failed to establish a *prima facie* case. Keller is simply not germane to the present obviousness analysis.¹⁷

¹³ Office Action at 9.

¹⁴ MPEP § 2144.08 I (“When a single prior art reference which discloses a genus encompassing the claimed species or subgenus but does not expressly disclose the particular claimed species or subgenus, Office personnel should attempt to find additional prior art to show that the differences between the prior art primary reference and the claimed invention as a whole would have been obvious.”); *id.*, II (“The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness.”); MPEP § 2144.08 II A 4 (“Office personnel should determine whether it would have been obvious . . . to select the claimed species or subgenus from the disclosed prior art genus.”).

¹⁵ Advisory Action at 2; *see also* MPEP § 2145 III.

¹⁶ In re Keller at 882 (emphasis supplied).

¹⁷ MPEP § 2142 (“The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. . . . The examiner bears the initial burden of factually supporting any *prima*

THE OFFICE IMPROPERLY MAINTAINED ITS TAKING OF OFFICIAL NOTICE.

Dependent Claim 3 was rejected under 35 U.S.C. § 103(a) as obvious over Rebaud in view of Yamamoto and Official Notice. Although the Office Action supplied evidence for its taking of Official Notice,¹⁸ the Office did not apply the cited references in rejecting Claim 3. Thus, Applicant maintains the traversal of the rejection of Claim 3 as outside the proper scope of Official Notice. Further, even assuming those references stand for the propositions for which they were provided, the Office Action did not evaluate whether it would have been obvious to modify Rebaud to delete content relative to the reproduction permission/inhibition decision section as recited in Claim 3.

CONCLUSION

Thus, the current grounds of rejection have not been clearly developed to such an extent that Applicant can readily judge the advisability of preparing a traditional appeal brief.¹⁹ Accordingly, Applicant respectfully requests that prosecution be re-opened.

Respectfully submitted,

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facie conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”).

¹⁸ Office Action at 6.

¹⁹ See MPEP § 706.07.